REMARKS/ARGUMENTS

After entry of this amendment, claims 1-16, 23-32 and 34-35 will be pending in this application. Claims 17-22 and 33 have been cancelled. Claims 1, 5, 7, 9, 14, 16, 23, 25, 26, and 34 have been amended as suggested by the Examiner during a phone call with the Undersigned on February 1, 2008. Specifically, "integrated circuit" has been clarified as "integrated circuit chip." Claim 32 has also been amended. Support for the amended claims can be found in the specification. No new matter has been added.

Claims 1-7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. (United States Patent number 5,514,893) in view of Verhaege et al. (United States Patent number 6,529,359). Claims 2 and 8 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al. and Toyashima (United States Patent application number 2001/0017755). Claims 9-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al. and Kwon et al. (United States Patent application number 2002/0163768). Claim 23 is rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al., Toyashima and Sher (United States Patent number 6,417,721). Claims 24 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al., Toyashima, Sher and Grugett (United States Patent number 5,767,733). Claim 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fugate (United States Patent number 6,525,594) in view of Tyckowski (United States Patent number 6,359,408) and Zhu et al. (United States Patent number 5,933,047). Claims 26, 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al., Fugate et al, Tyckowski and Zhu et al. Claims 32-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al., Toyashima, Sher and Fugate.

Reconsideration of these rejections and allowance of the pending claims in light of these amendments and remarks is respectfully requested.

Claim 1

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al. But these references do not show or suggest each and every element the claim. For example, claim 1, as amended, recites "the resistor is not on the first integrated circuit chip or the second integrated circuit chip." The cited references do not provide this feature.

The pending office action cites the resistor Rout in Figure 1 of Verhaege as providing this feature. (See pending office action, page 2, section 2.) But this resistor is included in an output circuit that provides an output signal. Thus, Verhaege's resistor Rout is on an integrated circuit chip that provides the input signal, that is, it is on the second chip. Reconsideration of this significant point of difference is requested.

Furthermore, Applicants respectfully submit that the pending office action does not adequately supported the rejection of obviousness. Rejections of obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385, Federal Register, Vol. 72, No. 195, p. 57528, sec. III, October 10, 2007. The pending office action states that "figure 1 [of Miyanage et al.] shows all elements of [claim 1] except for a detail of a driver circuit, not shown, that providing driving signal to pad 1." The pending office action further states, "However, Verhaege et al.'s figure 1 shows a driver circuit with ESD protection. Therefore, it is would have been obvious to one having ordinary skill in the art to use Verhaege et al.'s driver circuit to drive Miyanaga et al.'s circuit figure 1 for the purpose of saving cost." It is unclear as to how this assertion leads to a rational obviousness rejection of claim 1.

Applicants respectfully submit that the pending office action does not provide an articulated reasoning with a rational underpinning to support the conclusion of obviousness. The pending office action only states that "it would have been obvious…for the purpose of saving cost." However, it is unclear how the inclusion of additional elements from Verhaege et al. could produce any cost savings in the circuit of Miyanaga et al. Such a contention is counter intuitive and does not rationally support a legal conclusion of obviousness. The pending office

action has not articulated any reasoning as to why it would be obvious for one of ordinary skill in the art to combine the teachings of Verhaege et al. and Miyanaga et al.

For at least these reasons, claim 1 should be allowed.

Claim 9

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al and Kwon et al. As discussed in reference to claim 1 above, Miyanaga et al. and Verhaege et al. do not teach each and every element of currently amended independent claim 9. The additional reference to Kwon et al. does not remedy this deficiency.

For at least these reasons, claim 9 should be allowed.

Claim 27

Claim 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fugate in view of Tyckowski and Zhu et al.

Applicants respectfully submit that the pending office action has not adequately supported the rejection of obviousness. Again, rejections of obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. The pending office action has stated that no less than three references from disparate disciplines need be combined to render the claim 27 obvious and offers only conclusory statements as to why it would have been obvious to one of ordinary skill in the art to combine the cited references.

Fugate is titled "eliminating power-down popping in audio power amplifiers" and is directed to a circuit to prevent a voltage on the backgate of a transistor from dropping below a voltage on the current path node of the transistor. (See Fugate, abstract). Tyckowski is titled "low cost object detection circuit for vehicle closure." (See Tyckowski, title and abstract). Zhu et al. is titled "high voltage generating circuit for volatile semiconductor memories" and is directed to a high voltage generating circuit which provides a constant Vpp output without any threshold voltage drop and which does not suffer from latch-up problems. The pending office action provides only conclusory statements as to why it would be obvious to integrate discrete

elements from these three disparate disciplines to end up with the present invention. (See pending office action, page 8).

The only reason to combine these elements would be impermissible use of hindsight. According to the Court of Appeals for the Federal Circuit:

> "It is difficult but necessary that the decision maker forget what he or she has been taught...about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed Cir. 1983).

Here, one viewing only Fugate et al., Tyckowski and Zhu et al. would not have combined them in the manner proposed by the pending office action absent improper hindsight. The fact that the cited references are of different disciplines with disparate goals implies that pending office action has combined these references using improper hindsight.

In addition, the lack of an articulated reasoning with a rational underpinning to support the legal conclusion of obviousness is apparent in each of the pending office action's three conclusory statements in reference to claim 27. For example, the pending office action only states that it would have been "obvious to one having ordinary skill in the art to add Tyckowski's logic gate 29 to couple to the output of Fugate et al.'s comparator 34 for the purpose of disabling the switching function when not need[ed]." (See pending office action, page 8). This conclusion is only based on the existence of the two elements in two separate references. To add the logic gate to Fugate et al. would create a completely different circuit that would not achieve the goal of Fugate et al. With a comparator used in place of the switch, it would be possible for the "switch" in Fugate et al. to always be closed if the two inputs to the comparator were always held high. Applicants respectfully submit that doing so would produce a circuit that neither Fugate et al. nor Tyckowski contemplate or suggest. As such, the pending office action's obviousness rejection is not proper and should be withdrawn.

For at least this reason, claim 27 should be allowed.

Claim 32

Claim 32 is rejected under 35 U.S.C. §103(a) as being unpatentable over Miyanaga et al. in view of Verhaege et al., Toyashima, Sher and Fugate. As discussed in reference to claim 1 above, Miyanaga et al. and Verhaege et al. do not teach each and every element of currently amended independent claim 32. The additional three references to Toyashima, Sher and Fugate et al. do not remedy this deficiency. For at least these reasons, claim 32, and all claims dependent thereon, should be allowed.

Other claims

The remaining claims depend on one of the above claims and should be allowed for at least the same reasons and for the additional limitations they recite.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal notice of allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

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